PATENT
Attorney Docket No. 05793.3038-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Colleen C. LUBKING et al.	)	Group Art Unit: 3692
	)	
Application No.: 09/882,304	)	Examiner: MILEF, Elda G.
	)	
Filed: June 18, 2001	)	Confirmation No.: 6864
	)	
For: METHOD AND SYSTEM FOR OFFERING FINANCIAL PRODUCTS BASED ON A CUSTOMER'S DETERMINED LIFE STATUS	)	

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellants present this Reply to the Examiner's Answer mailed September 18, 2007.

REMARKS

I. Status of Claims

In response to the Appeal Brief filed on June 29, 2007, the Examiner has maintained the rejection of claims 1, 14, 17, 24, and 31-33 under 35 U.S.C. § 103(a) as being unpatentable over *Moran* (U.S. Patent No. 6,430,542) and the rejection of claims 7, 13, 23, and 30 as being unpatentable over *Moran* in view of *Kunzle et al.* (U.S. Patent Publication No. 2002/0023051).[1]

II. Response to Examiner's Arguments in the Answer

Appellants respectfully traverse the Examiner's rejection of claims 1, 7, 13, 14, 17, 23, 24, and 30-33 under 35 U.S.C. § 103(a). Appellants maintain that a *prima facie* case of obviousness has not been established for reasons of record and for the additional reasons set forth below.

In the Examiner's Answer, the Examiner asserts:

> KSR forecloses Appellants' argument that a specific teaching is required for a finding of obviousness.

(*Examiner's Answer*, p. 8.) Appellants acknowledge that a finding of obviousness may still be found wherein the prior art reference(s) fail to explicitly teach each and every claim element. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). However, in *KSR*, the Court did not abandon the use of *Graham v. John Deer Co.* factors in determining obviousness, but instead stated that the teaching-suggestion-motivation (TSM) test should not be applied in an overly rigid manner. (*See id.* at 1739.)

[1] As indicated in the Appeal Brief filed on June 29, 2007, claims 2-6, 8-12, 15, 16, 18-22, and 25-29 have been cancelled.

Moreover, as is set forth in the United States Patent and Trademark Office (USPTO) new guidelines for the obviousness type rejections, the USPTO holds that the "*Graham* factors, including secondary considerations when present, are the controlling interest in any obviousness type rejection." M.P.E.P., § 2141 (Rev. 6, September 2007.) Once the Examiner has applied the *Graham* factors, to support a determination of obviousness, the Examiner must articulate a clear reason why the claimed invention would have been obvious. (*Id.*)

As set forth in the Appeal Brief filed on June 29, 2007, *Moran* fails to disclose the claimed financial product, as recited in independent claims 1, 17, and 24. In response, the Examiner alleges that "Moran discloses that the preparation of a financial plan involves eventually conducting financial transactions for clients, and that financial advisors are aware of the financial products which are provided by his or her company in order to address the client's and concerns." (*Examiner's Answer*, p. 9.) The Examiner's allegation supports Appellants position. Specifically, the financial plan and the financial product disclosed by *Moran* are two completely and distinct items. Accordingly, contrary to the Examiner's assertion, *Moran* specifically teaches that a financial plan does not equate to a financial product. (*See, e.g.*, *Moran*, 1:25-51.)

Moreover, *Moran* also, at a minimum, fails to disclose:

> selecting, from a set of financial products, a first financial product for the customer based on said life status using a data structure that relates each life status type to a particular financial product;
> determining the creditworthiness of the customer; and
> optimizing said first and second financial products based on the creditworthiness,

as recited in independent claim 1, and similarly recited in independent claims 17 and 24.

For the alleged disclosure of the claimed selecting step, the Examiner cites to col. 14, lines 35-54 of *Moran*. (*Examiner's Answer*, p. 9.) However, this passage of *Moran* is directed to the creation of financial plans and not the selecting of financial products as claimed. Moreover, *Moran* fails to disclose "a data structure that relates each life status type to a particular financial product," as claimed. Instead, *Moran* discloses that "the advisor preferably selects or creates a specific financial plan at the initiation of the FAS 10." (*Moran*, 14:40-42.) And, as indicated above, the financial plan of *Moran* does not equate to the claimed financial product.

As these claims elements are not disclosed by *Moran*, the burden is on the Examiner to articulate a clear reason why the claimed invention would have been obvious. M.P.E.P., § 2141 (Rev. 6, September 2007.) However, the Examiner has failed to articulate such a reason. Therefore, the rejection of independent claims 1, 17, and 24 under 35 U.S.C. § 103(a) is legally deficient.

The Examiner admits that *Moran* fails to disclose "determining the creditworthiness of the customer; and optimizing said first and second financial products based on the creditworthiness," as claimed. (*Examiner's Answer*, p. 6.) In an attempt to alleviate this deficiency of *Moran*, the Examiner relies on the teachings of *Kunzle et al*. Specifically, the Examiner alleges that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Moran to include determining the creditworthiness of a borrower as taught by Kunzle in order for the financial institution to reduce credit risk." (*Id.* at p. 7.) Appellants, respectfully submit that the Examiner has failed to articulate a reasoning to support a conclusion of obviousness as is required.

The determination of creditworthiness for financial products as disclosed by *Kunzle et al.* is not applicable to the financial products of *Moran*. For example, *Kunzle et al.* discloses financial products comprising an automobile loan, mortgage, home equity loan, and credit card. (*Kunzle et al.*, Abstract.) These financial products include a lender and a borrower. Accordingly, to protect the financial interests of the lender, *Kunzle et al.* discloses the use of a credit score to determine the creditworthiness of the borrower. (*See id.* at ¶ 0037.) On the contrary, the recommendations contained within the financial plan disclosed by *Moran* are not financial products which include a lender or borrower. (*Moran,* FIG. 49.) For example, these recommendations include "invest $20,000 in IDS stock market certificates over the next year" and "consider purchasing and IDS life." (*Id.*) As these recommendations do not include a lender or borrower, the need to determine the creditworthiness of the borrower "in order for the financial institution to reduce credit risk," as suggested by the Examiner, does not exist. Accordingly, the Examiner has failed to clearly articulate a reason why the claimed invention would have been obvious, and therefore, the rejection under § 103(a) is legally deficient.

Because *Moran* and *Kunzle et al.*, taken individually or in combination, fail to teach or suggest all the claim elements, and because the Examiner has failed to proffer a viable reason why the claimed invention would have been obvious, the rejection of independent claims 1, 17, and 24 under 35 U.S.C. § 103(a) is legally deficient. For at least the same reasons as independent claims 1, 17, and 24 the rejection of dependent claims 7, 13, 14, 23, and 30-33 under 35 U.S.C. § 103(a) is also legally deficient.

Appellants thereby respectfully request that the rejection of claims 1, 7, 13, 14, 17, 23, 24, and 30-33 under 35 U.S.C. § 103(a) be reversed by the Board.

III. Conclusion

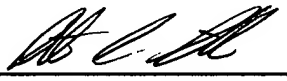
For the reasons set forth above, supplementing those presented in the Appeal Brief filed on June 29, 2007, pending claims 1, 7, 13, 14, 17, 23, 24, and 30-33 are allowable and reversal of the Examiner's rejection is respectfully requested.

If there are any fees due that are not enclosed herewith, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 19, 2007

By: 

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